

**REMARKS**

Claims 1-31 are pending in the present application.

Reconsideration of the application is respectfully requested in view of the following responsive remarks. Specifically, in the Office Action of January 10, 2007, the Examiner rejected claim 31 under 35 U.S.C. 112, second paragraph as being indefinite and rejected claims 1-31 under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,709,976 (hereinafter “Malhotra”) in view of U.S. Patent No. 5,614,325 (hereinafter “Chartier”); U.S. Patent Application No. 2003/0224192 (hereinafter “Tani”) in view of Chartier; and U.S. Patent Application No. 2003/0207089 (hereinafter “Nakamura”) in view of Chartier.

It is respectfully submitted that the presently pending claims be examined and allowed.

**Rejections Under 35 U.S.C. § 112**

The Examiner rejected claim 31 as not being clearly defined in light of claim 1. Claim 31 previously read “A media sheet as in claim 1, wherein the receiving layers are devoid of a dedicated binder.” The Examiner is still alleging that the term binder is broad covering compounds/polymers that can also be discharge control agents even though the limitation of “dedicated” binder was added.

Claim 31 has been amended to read “A media sheet as in claim 1, wherein the receiving layers are devoid of a dedicated binder, wherein the discharge control agent is not a binder.” Thus, there should be no confusion as to whether or not a discharge control agent can be considered a binder in the context of the invention. Withdrawal of this rejection is respectfully requested.

**Rejections Under 35 U.S.C. § 103**

Before discussing the obviousness rejections herein, it is thought proper to briefly state what is required to sustain such a rejection. The issue under § 103 is whether the PTO has stated a case of *prima facie* obviousness. According to the MPEP § 2142, the Examiner has the burden and must establish a case of *prima facie* obviousness by showing the prior art reference, or references combined, teach or suggest all the claim limitations in the instant application. Further, the Examiner has

to establish some motivation or suggestion to combine and/or modify the references, where the motivation must arise from the references themselves, or the knowledge generally available to one of ordinary skill in the art. Ultimately, the Examiner must show that the combination has proper motivation, provides all the elements of the present invention, and has a likelihood of success at providing the present invention. The Applicant respectfully asserts the Examiner has not satisfied the requirement for establishing a case of *prima facie* obviousness in any of the rejections.

The Examiner uses Malhotra in view of Chartier, Tani in view of Chartier, and Nakamura in view of Chartier, respectively, to reject all of the claims. All three rejections, however, suffer from the same deficiencies. Malhotra, Tani, and Nakamura individually, do not disclose a layer equivalent to Applicant's base coating layer containing inorganic pigments or a discharge control agent. The Examiner then uses Chartier to provide the discharge control agent and inorganic pigment. However, any one of these three combinations would not provide each and every element of the present invention, nor would it lead one skilled in the art to the multi-layered coating system of the claimed invention. Additionally, it is noted that Chartier does not include any discussion of hollow particles, which is an essential element in the Applicant's invention.

It is important to note that the claimed invention is not just a random batch of various components that can be mixed and matched at will. Rather, the invention is made up of individual layers with specific components in each layer. Thus, the relationship of what is in each layer, as well as the inter-layer relationship is key to the invention. These relationships are actual elements of the claim language, and it is these elements that are missing from the cited prior art. Again, individual components cannot be mixed and matched as suggested by the Examiner. For example, the Examiner is using an electrostatic printing layer of Chartier (the layer where toner is received in Chartier) to provide components that are to be added to the hydrophobic barrier layer of Malhotra, Tani or Nakamura. If anything, the single layer in Chartier is more analogous to the image receiving layer of Malhotra, and the toner-image receiving layer of Tani and the Nakamura. It is this secondary layer, which is added to the first or base stock layer in Applicant's case, and support layer in the prior art references, that contains hollow particle pigments. Disclosure of such pigments in the prior art references is absent. Furthermore, the Chartier reference only discloses or

offers a suggestion of adding inorganic pigments and a discharge control agent to the receiving layer, not the base coating layer.

It is noted that Applicant's invention requires that there be base stock, two base coating layers (one on each side), and two receiving layers (one on each side). These claims also require that the base coating layers be different than the receiving layers. In other words, the claimed media sheets must include at least five (5) layers, where base coating layers are different than receiving layers. Chartier's teachings are only analogous to the receiving layers. Thus, there is no suggestion or motivation to combine the elements of the receiving layer, as taught by Chartier, to the analogous base coat layer of the prior art references.

Thus, as described above, using the single layer of Chartier to replace either layer of Malhotra, Tani, or Nakamura would not be sufficient to render the claimed invention obvious. The only way to utilize Chartier in combination with Malhotra, Tani or Nakamura that would lead to the claimed invention would be to pick and choose known components from each of the references, and then use those references to reconstruct the claimed layers of the present invention, including their claimed relationship to one another and to the substrate. This type of analysis amounts to impermissible hindsight. Alternatively, by choosing individual known ingredients from the two references and putting those together in multiple layers precisely as is presently claimed would require undue experimentation.

As a final note, the Examiner rejects many dependent claims based on essentially an inherency argument. Specifically, the Examiner implies that once the proper motivation or suggestion is found to combine two or more references to reach the claimed invention, one of ordinary skill in the art would be further motivated to optimize the invention. In other words, one of ordinary skill would be motivated to utilize such things as routine experimentation to determine the optimum content of each component, the coating thickness or coating weight, and optimum pigment particle size and particle size distribution to utilize in the coating layers based on the desired color, coating and matting properties, and particular end use, etc. However, as argued above, the Applicant disputes that any such motivation or suggestion to combine the prior art references existed in the first place. And even if a motivation did exist to combine the references to arrive at the broad concept, there still needs to be proper motivation or suggestion to combine the references to arrive at all

limitations in the dependent claims (MPEP 2143.03). Additionally, MPEP 2144.03 states that "Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge.... Holding that general conclusions concerning which are "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection." This section of the MPEP goes on to say that the Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. The Examiner has not done this regarding rejections of dependent claims having limitations that are not explicitly mentioned in the prior art references.

The Applicant recognizes that it is the combination of the two references that the Examiner is using to arrive at the claimed invention and not either reference individually. The above discussion is provided to show why the two references are not believed to be properly combinable, and that even if such a combination were made, the combination would still fail to provide each and every element of the present invention, i.e. claim elements related to relationships between layers, etc. are missing. Reconsideration of this rejection on these grounds is respectfully requested.

**CONCLUSION**

In view of the foregoing, Applicants believe that claims 1-31 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone W. Bradley Haymond (Registration No. 35,186) at (541) 715-0159, or the undersigned, so that such issues may be resolved as expeditiously as possible. Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025.

Dated this 10<sup>th</sup> day of April, 2007.

Respectfully submitted,



Gary P. Oakeson  
Attorney for Applicant  
Registration No. 44,266

THORPE NORTH & WESTERN, LLP  
8180 South 700 East, Suite 200  
Sandy, Utah 84070  
(801) 566-6633

On Behalf Of:  
HEWLETT-PACKARD COMPANY  
1000 NE Circle Blvd., m/s 422B  
Corvallis, OR 97330-4239  
(541) 715-0159